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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,527	12/05/2001	Michael G. Bramucci	CL1709 US NA	7153

23906 7590 06/25/2003

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EXAMINER

KATCHEVES, KONSTANTINA T

ART UNIT	PAPER NUMBER
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1636

12

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,527

Applicant(s)

BRAMUCCI ET AL

Examiner

Konstantina Katcheves

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-41 are pending in the present application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2,5, 17, 20, 22-25 and 34-38 drawn to the isolated nucleic acid of SEQ ID NO:1, plasmid comprising SEQ ID NO:1 and transformed bacteria, classified in class 435, subclass 252.3.
- II. Claims 3 and 4, drawn to an isolated polypeptide of SEQ ID NO:2, classified in class 530, subclass 350.
- III. Claims 6, 7 and 9, drawn to method of isolating nucleic acid, classified in class 435, subclass 6.
- IV. Claims 9, 10 and 13, drawn to an isolated nucleic acid of SEQ ID NO:3, classified in class 536, subclass 23.1.
- V. Claims 11 and 12, drawn to isolated polypeptide of SEQ ID NO:4, classified in class 530, subclass 350.
- VI. Claims 14-16, drawn to a method of isolating a nucleic acid, classified in class 435, subclass 6.
- VII. Claims 18, 20, 21 and 22-25, drawn to a plasmid and transformed bacteria, classified in class 435, subclass 252.3.
- VIII. Claim 19, drawn to a plasmid of SEQ ID NO:5, classified in class 435, subclass 320.1.

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- IX. Claim 26, drawn to a plasmid of SEQ ID NO:6, classified in class 435, subclass 320.1.
- X. Claim 27, drawn to the plasmid of SEQ ID NO:7, classified in class 435, subclass 320.1.
- XI. Claims 28-38, drawn to a method for expressing a nucleic acid, classified in class 435, subclass 91.4.
- XII. Claims 39-41, drawn to a method for expressing a nucleic acid, classified in class 435, subclass 91.4.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups III, VI, XI and XII are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups these groups comprise steps which are not required for or present in the methods of the other groups: probing a library with SEQ ID Nos: 1 or 3 (Group III), probing a genomic library with SEQ ID NO:4 (Group VI), providing the nucleic acids of SEQ ID Nos: 1 and 3 (Group XI), and providing the nucleic acid of SEQ ID NO:1 and at least one other plasmid in a different incompatibility group (Group XII). Thus, the operation, function and effects of these different methods are different and distinct from each other. Moreover, the end results of each of these methods differ. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

The protein and nucleic acid sequences of Groups I, II, IV, V, VII, VIII, and XI are chemically, biologically, and functionally distinct from each other and thus one does not render the other obvious. The protein of Groups II and V are not required to produce the DNA of and

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plasmids of the other groups. The DNA can be replicated in vectors without use of the protein. The DNA of Groups I, IV, VII, VIII and IX are not required to produce the proteins of Group II and IV, which can be produced synthetically or isolated from cells. Therefore, the inventions of the two groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and the search required for each of the above groups is not required for the others, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konstantina Katcheves whose telephone number is (703) 305-1999. The examiner can normally be reached on Monday through Friday 7:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3388.

Konstantina Katcheves
June 3, 2003


REMY YUCEL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600